



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/695,623	10/24/2000	Hiroyuki Honma	9792909-4845	2772

26263 7590 08/29/2006

SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
----------	--------------

2136

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/695,623

Applicant(s)

HONMA, HIROYUKI

Examiner

Brandon S. Hoffman

Art Unit

2136

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Claims 1-4, 6-13, and 15-18 are pending in this office action.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 6, 2006, has been entered.

3. Applicant's arguments, filed June 6, 2006, have been fully considered but they are not persuasive.

Rejections

4. The text of those sections of 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

5. Claims 1-4, 6-8, 10-13, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. (U.S. Patent No. 5,359,725) in view of Nakashima et al. (U.S. Patent No. 5,708,650).

Regarding claims 1 and 10, Garcia et al. teaches an information management method/apparatus comprising:

- Generating protection information for protecting the storage area of a recording medium storing a second string of codes recorded by a second **audio** coding technique from any recording, editing and erasing operations of a first apparatus adapted to handle a first string of codes by a first **audio** coding technique and refer to the first management data stored in a first management area (col. 2, line 46 through col. 3, line 10, col. 3, line 21 through col. 5, line 49);
- Arranging said protection information in the first management data area as one of said first management data (col. 4, lines 1-6); and
- Protecting the storage area of the medium storing said second string of codes from any recording, editing and erasing operations of said first apparatus, while allowing reproducing operations of said first apparatus (MAC files [first code] are allowed to be reproduced while in the MAC computer [first apparatus]), on the basis of said protection information when the medium storing said second string of codes is operated by said first apparatus (col. 2, line 46 through col. 3, line 10, MAC files [first code] and MS-DOS files [second code] are both stored on the same medium, when placed in a MAC computer [first apparatus], only the MAC

files [first code] will be able to be read, while the MS-DOS files [second code] are protected from any recording, editing, and erasing operation of the MAC computer [first apparatus]).

Garcia et al. does not teach wherein said protection information indicates that the protection mode of the track on the medium is prohibited from rewriting.

Nakashima et al. teaches wherein said protection information indicates that the protection mode of the track on the medium is prohibited from rewriting (fig. 20, 'write-protection flag' and col. 3, lines 10-19).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the protection information indicate that the protection mode of the track on the medium is prohibited from rewriting, as taught by Nakashima et al., combined with the method/apparatus of Garcia et al. It would have been obvious for such modifications because the protection flag allows data to remain on the medium for a user-added benefit. Also, rewriting needs to be prohibited because a rewriting action on the directory structure will destroy the link between the file name and the actual location of the file.

Regarding claims 2 and 11, Garcia et al. as modified by Nakashima et al. teaches said first apparatus is permitted to reproduce only the part of the first string of

Art Unit: 2136

codes on the basis of said protection information when a single string of codes generated by means of both said first **audio** coding technique and said second **audio** coding technique is recorded on said recording medium (see col. 1, lines 23-27 of Garcia et al., only the MAC computer [first apparatus] will be able to reproduce the MAC files [first code] when both MAC files [first code] and MS-DOS files [second code] are on the medium).

Regarding claims 3 and 12, Garcia et al. as modified by Nakashima et al. teaches said protection information indicates that the area that can be used by said first apparatus for recording is made nil in said area on the medium or said area on the medium is made smaller than the allowable area of said first apparatus (see col. 5, lines 8-29 of Garcia et al.).

Regarding claims 4 and 13, Garcia et al. as modified by Nakashima et al. teaches said protection information indicates that the storage information of the address information indicating the position of the area on the medium that can be used for recording by said first apparatus is made equal to nil (see col. 5, lines 8-29 of Garcia et al.).

Regarding claims 6 and 15, Garcia et al. as modified by Nakashima et al. teaches a second management data area that can be referred to only by the second apparatus adapted to handle the second string of codes or both the first string of codes

Art Unit: 2136

and the second string of codes is provided on said medium and the first management data area arranged in said second management data area except said protection information (see col. 1, lines 23-27 of Garcia et al., only the MS-DOS computer [second apparatus] will be able to reproduce the MS-DOS files [second code] when both MAC files [first code] and MS-DOS files [second code] are on the medium).

Regarding claims 7 and 16, Garcia et al. as modified by Nakashima et al. teaches said second apparatus is adapted to refer to both said first management data area and said second management data area (see col. 2, lines 3-11 of Garcia et al., both formats [MAC and MS-DOS] are transferred to an MS-DOS formatted drive, a MS-DOS computer [second apparatus] will be able to read both the MAC and DOS directories).

Regarding claims 8 and 17, Garcia et al. as modified by Nakashima et al. teaches said second apparatus is adapted to disregard said first management data area and refers to only the second management data area when said protection information is arranged in said first management data area (see col. 1, lines 23-27 of Garcia et al., only the MS-DOS computer [second apparatus] will be able to reproduce the MS-DOS files [second code] when both MAC files [first code] and MS-DOS files [second code] are on the medium).

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garcia et al. (USPN '725) in view of Nakashima et al. (USPN '650), and further in view of Takezawa (U.S. Patent No. 5,392,265).

Regarding claims 9 and 18, Garcia et al./Nakashima et al. teaches all the limitations of claims 1 and 6, and also claims 11, and 15-17, respectively. However, Garcia et al./Nakashima et al. does not teach said second apparatus initializes said first management data area and allows the medium to be used by said first apparatus for recording, editing and erasing when said second string of codes no longer exists on said medium.

Takezawa teaches said second apparatus initializes said first management data area and allows the medium to be used by said first apparatus for recording, editing and erasing when said second string of codes no longer exists on said medium (col. 2, lines 31-43).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow recording, editing, and erasing of data after a second string of codes no longer exists on a medium, as taught by Takezawa, combined with the method/apparatus of Garcia et al./Nakashima et al. It would have been obvious for such modifications because this well-known task is common in record management of data on an optical medium. When data is added, deleted, or edited, the TOC is

Art Unit: 2136

automatically updated to reflect the changes made. This implies that when a second string of codes is deleted, i.e. no longer exists on a medium, the TOC is updated to reflect the change, therefore informing the apparatus adapted to the old standards that information exists in the old format exclusively. This would allow the first apparatus recording, editing, and erasing rights.

Response to Arguments

6. Applicant amends claims 1, 2, 10, and 11.
7. Applicant argues that Garcia as modified by Nakashima fails to teach **audio** coding techniques, and therefore fail to teach the independent claims (page 7).

Regarding applicants argument, examiner disagrees with applicant. Garcia teaches creating a storage device (CD-ROM) that contains both MAC and PC files, probably containing the same application, so that one release of the storage device can be used by both MAC and PC users, while preventing users of one computer type from accessing files created in the other computer type. For example, MAC files cannot be accessed in a PC machine, and vice versa. Column 1, lines 66-68 of Garcia says that the CD stored data and programs. The data can be any type of data, audio included. A PC coding technique would be a windows media file, while a MAC coding technique would be an AIFF audio file. Each file is accessible by the proper machine (either PC or MAC), but not accessible by the opposite machine (either MAC or PC).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brandon S. Hoffman

BH

**NASSER MOAZZAMI
PRIMARY EXAMINER**

Nasser Moazzami
8/24/06